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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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HM22/1208
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EXAMINER

PATEL, S

ART UNIT

PAPER NUMBER

1611

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DATE MAILED: 12/08/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/272,916

Applicant(s)
Klaus-Juergen Pees et al.

Examiner
Sudhaker Patel

Group Art Unit
1611



- ☐ Responsive to communication(s) filed on _____.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-8 is/are pending in the application.
- Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-8 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claims _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☒ Notice of References Cited, PTO-892
- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Claim Rejections - 35 U.S.C. § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-4, 6-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(1). "Optionally substituted" in claim 1 is unclear as to nature and number of substituent(s) intended. Specification's definition is open-ended.

(2). In claim 6, the term M is not defined properly. Specification on page 6 cites "M represents a hydrogen atom or a free or complexed metal atom, preferably selected from the group consisting of Li, Na, K, Zn and Cu. What is intended? A metal salt in the ionic form or a covalently bonded metal complex?"

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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Claims 1-4, 6-8 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/use the invention.

1). Scope of "optionally substituted" in claim 1 read on all functional moieties regardless of complexity of structure for which there is no sufficient enabling disclosure by way of working exs. or starting material sources for such a scope. Note *In re Lund*, 376 F.D. 982, 153 USPO 625 (CCA 1967); *In re Wiggins*, 488 F.D. 538, 179 USPO 421 (CCA 1971). Such compounds embraced by the instant scope have not been shown by way of representative examples will have the minimum activity needed to practice the invention. Compounds made and tested are not representative of the scope of claim 1. Note *In re Surrey* 151 USPO 724 regarding sufficiency of disclosure for a Markush group.

Claim Rejections - 35 U.S.C. § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pees et al. (EP '113 or US ' 996).

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Pees at al. generically discloses several 5-halo-7-amino-6-aryl-1,2,4-triazolopyrimidines and their derivatives claimed herein for the same use as fungicides. See columns 1,2, definitions of all R variables and egs. 17, 48 in Table 1. Also see column 2 for preferred definition of R¹ which includes R¹ as C₁₋₁₂ alkyl optionally substituted with 1 or more substituents selected from halogen nitro, cyano... etc groups. Note, compounds mentioned above differ from the instantly claimed compounds by way of having alkyl, alkadienyl vs. Instant fluorinated ethyl or fluorinated isopropyl groups for instantly claimed compounds with otherwise identical groups. Note that Pees teaches both alkyl and haloalkyl at R¹. Note also preparation of such compounds is accomplished by the route claimed herein employing corresponding dihalo intermediates. Thus it would have been obvious to one skilled in the art at the time the invention was made to expect instant 7-CF₃-substituted alkylamino derivatives to be also fungicides and their preparation via reactants employed in claim 6 within the skill of the art as evidenced by the prior art applied herein.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-8 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of U.S. Patent No. 5948 783 in view of Pees (EP'113 or US'996). Instant claims are not patentably distinct because of following reasons;

Pees claims 7- trifluoromethylalkylamino triazolopyrimidines similar to instantly claimed compounds as fungicides. The sole difference is substitution on phenyl ring, namely Pees claims methyl, halo vs. Instant nitro or alkoxy. The secondary reference(EP'113 or US'996) teaches NO₂, alkoxy as well as alkyl, halo as substituents on the phenyl ring in similar compounds. See col. 2 in US Pees. Thus, instantly claimed alkoxy phenyl, and nitro phenyl derivatives are not patentably distinct over derivatives claimed in US'783 in view of equivalency teaching outlined above.

Note since US'783 has the same inventive entity it cannot be applied under 103.

6. ***Claim Rejections - 35 U.S.C. § 102***

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

Claims 1-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Pfrengle (US'534).

Pfrengle discloses several compounds within instant scope for use as fungicides. See 2nd species in Table 1, col. 12, and 2nd - 4th species in col. 13.

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Claims 1-8 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7, 10-20 of U.S. Patent No. 5981534. Although the conflicting claims are not identical, they are not patentably distinct from each other because they embrace overlapping subject matter as described in 102 rejection above. Note in particular species in dependent claims of US'534.

US'534 applied above has at least one inventor in common. To preclude a rejection under 102(f) or (g) and/or 103/102(f) or (g), applicants need to provide evidence showing that the invention was owned by, or subject to an obligation of assignment to the same entity as US'534, at the time this invention was made. See MPEP 706.02(I).

References cited in the Information Disclosure Statement are made of record and considered.

7. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

The PCT application is incorrectly being claimed under foreign priority rather than under 35 U.S.C. 120. Note mention of such application must be inserted into specification page 1 with its relationship (eg. CONT, CIP) to current case clearly set forth.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sudhaker Patel whose telephone number is (703) 308 4709. The examiner can normally be reached on Monday thru' Friday from 8:30 AM to 5:00 PM. If attempts to reach the examiner by the phone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached at (703) 308 4716.


A facsimile center has been established for Group 1600. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier numbers for accessing the facsimile machine are (703) 308-4556 or (703) 305-3592.

Any inquiry of general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308 1235.



S. B. K. Patel
sp

December 2, 1999.



Mukund J. Shah
Mukund J. Shah
Supervisory Patent Examiner
Art Unit 1611